

REMARKS

In response to the outstanding Office Action mailed March 5, 2009, Applicant submits the further Declaration of John Michael Jensen, in which additional materials have been added to Exhibits 9-13 to demonstrate that the concept of the limitations in the claimed invention directed to contact information of the receivers being hidden from the communication device, and identification information of the user is tracked for a return communication from the Receiver were conceived prior to April 20, 2000. In this connection, Applicant notes that the remaining exhibits, namely Exhibits 1-8 are unchanged from Exhibits 1-8 as previously submitted.

In the Action, the Examiner contends that the Declaration previously submitted under 37 CFR 1.131 is not sufficient to demonstrate that Applicant conceived the invention, as claimed, prior to April 20, 2000.

As set forth in the Declaration submitted herewith, Applicant commenced doing research on the invention as early as February 2, 2000. This research included in February 2000 downloading information including software known as form-to-mail 2.0 included in Exhibit 12 from which it is clear that an email address can have a hidden attribute so that the email address can be hidden if desired. Applicant obtained further information relating to this functionality as shown in Exhibits 11, 12 and 13, and as explained in detail in the Declaration submitted herewith, for example in paragraphs 11-23. While it was known in the art that an email address can have a hidden attribute so that the email address can be hidden if desired, Applicant notes that it is the combination of elements set forth in the independent claims which distinguishes the invention over the prior art. That is, the specific novelty of the invention lies mainly in the contact information of the receiver being hidden from the communication device, and identification of the user being tracked for a return text communication from the receiver. The prior art is mainly concerned with hiding contact information of the sender not the receiver. Applicant has adopted known techniques for hiding contact information of the sender for use in the particular application as disclosed and claimed by Applicant.

In this connection, since it is clear from the specification that the ability to hide a receiver's email address is desirable, see paragraph [0134] of the published specification, and since Applicant has demonstrated that Applicant began to research this aspect of the invention in February 2000, and obtained detailed instructions as to how this may be accomplished prior to April 20, 2000, Applicant submits that it has been demonstrated that Applicant had conceived this aspect of the invention at least as early as February 2000 and had taken affirmative steps to reduce this aspect of the invention to practice prior to April 20, 2000. That is, Applicant not only conceived this aspect of the invention prior to April 20, 2000, but was actively involved in researching how to reduce this aspect of the invention to practice prior to April 20, 2000.

In the Office Action mailed September 11, 2008, at page 6, the Examiner states: "at the time of invention, it would have been obvious to one of ordinary skill in the art to modify Cook in view of Keen by adopting teachings of Liu to facilitate anonymous communication between parties, combine prior art elements according to known methods to yield predictable results, apply a known technique to a known device or method ready for improvement to yield a predictable result."

Since Liu has an earliest filing date of September 5, 2000, since Applicant has demonstrated that Applicant had conceived the invention, in particular the element wherein "contact information of the receiver is hidden from the communication device, and identification of the user is tracked or a return communication from the receiver" Applicant's invention predates Liu which is therefore not prior art.

At said page 6 of the September 11, 2008 Office Action, the Examiner further acknowledges that Cook in view of Keen does not expressly recite contact information of the receiver is hidden from the communication device. The Examiner does note that Keen teaches that the phone number of the user is hidden. However, while correct, it is not relevant since Applicant's invention keeps the receiver's contact information hidden, not the user information.

In the present Action, the Examiner for reasons which are unclear, does not cite Liu, but contends at page 4, that Keen teaches the concept wherein the phone number, email and information of the users are hidden, referring to Keen, page 10 and 14 at page 4 of the Action. The Examiner further contends that identification information of the user is tracked for a return

communication from the receiver referring to Keen at page 11. However, it is quite clear that Keen is referring to availability by telephonic communication rather than text being transmitted from the communication device by a user to a receiver. Applicant has amended the independent claims 21, 31, 39 to make it clear that the return communication from the receiver is also a text communication.

Additionally, Applicant notes that the pages from Keen.com are for the period between January 1, 1996 and January 22, 2004. However, it is not at all clear that the particular pages relied upon by the Examiner were available prior to February 2000 by which time Applicant had already conceived the invention. Thus, if the Examiner continues to rely upon Keen.com, it is requested that the Examiner provide evidence that the particular pages relied upon were published prior to February 2000.

If the Examiner believes a telephone conference would be useful in moving the case forward, he is encouraged to contact the undersigned at (310) 207-3800.

If necessary, the Commissioner is hereby authorized in this, concurrent and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2666 for any additional fees required under 37 C.F.R. §§1.16 or 1.17, particularly, extension of time fees.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated:

6/4/09

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I hereby certify that this correspondence is being submitted electronically via EFS Web on the date shown below to the United States Patent and Trademark Office.


Linda Metz

6/4/09